

### **REMARKS**

Claims 1-18 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 6, 11, and 12 to further clarify the invention. In addition, by this Amendment, Applicant adds claims 17 and 18. Claims 17 and 18 are clearly supported throughout the specification, *e.g.*, Fig. 8.

### **Summary of the Office Action**

The Examiner withdrew the previous rejection. The Examiner, however, found new grounds for rejecting claims 1-16. In particular, claims 1, 2, 4-7, and 9-15 stand rejected as being allegedly anticipated by a newly found reference U.S. Patent No. 6,230,170 to Zellweger et al. (hereinafter "Zellweger"). Claims 3 and 8 stand rejected as being allegedly obvious over Zellweger in view of U.S. Patent No. 6,426,761 to Kanevsky et al. (hereinafter "Kanevsky"). Claim 16 stands rejected as being allegedly obvious over Zellweger in view of U.S. Patent No. 5,230,063 to Hoeber et al. (hereinafter "Hoeber").

### **Preliminary Matter**

As a preliminary matter, the Examiner's initialing of the references listed on the form PTO/SB/08 A & B submitted with the Information Disclosure Statement filed on May 7, 2004 is kindly noted.

### **Claim Rejections**

The Examiner rejected claims 1, 2, 4-7, and 9-15 under 35 U.S.C. § 102(e) as being anticipated by Zellweger, claims 3 and 8 as being obvious over Zellweger in view of Kanevsky,

and claim 16 as being obvious over Zellweger in view of Hoeber. Applicant respectfully traverses these rejections in view of the following comments.

Of the rejected claims, only claims 1, 6, 11, and 12 are independent. First, independent claim 1, as now amended, recites: “wherein each of the plurality of elements comprises at least one sub-element that the user can manipulate.” For example, in an illustrative, non-limiting embodiment, the user can manipulate a sub-element while referring to the elements that are not selected.

Zellweger, on the other hand, teaches having primary text with annotation tags, where the text of the annotation tag is viewed by simply placing a cursor over the tag. In particular, Zellweger teaches having a text sample 140 that includes text 142 having a star shaped symbols annotation tags 144. When a user selects a tag 144, the system calculates the amount of space required for displaying the annotation text and reduces, decreases the size of the main text to make room for the annotation. Annotation is displayed and the main text is displayed on the screen in a reduced size (Figs. 11 and 12; col. 11, line 22 to col. 12, line 32).

Moreover, Zellweger teaches a textual representation that supports multiple nesting links functioning as an enhanced hypertext. For example, selection of annotation tag causes the text to move apart and accommodate presentation of a multiple link. For example, selection of one of the links opens yet another link related to the first link. The multiple link 214 still remains in view, preserving context during search of the multiple link (Figs. 23 and 24; col. 13, line 8 to col. 14, line 20).

Zellweger, however, fails to teach or suggest sub-elements that the user can manipulate. That is, in Zellweger, the expansion of the text is for facilitating visualization of a small image,

small text, hidden text, and the like. In other words, Zellweger only teaches providing the user with additional information for reading. In Zellweger, when a tag is selected, for example, no sub-elements that can be manipulated by the user are provided. Zellweger teaches providing addition text or image that includes additional information that can only be read and not manipulated.

Therefore, “wherein each of the plurality of elements comprises at least one sub-element that the user can manipulate,” as set forth in claim 1 is not anticipated (and is not obvious over) Zellweger, which only provides additional information that the user can read and lacks having a sub-element that the user can manipulate. For at least this exemplary reason, Applicant respectfully submits that independent claim 1 is patentably distinguishable from (and is patentable over) Zellweger. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 1. Claims 2, 4, and 5 are patentable at least by virtue of their dependency on claim 1.

With respect to the other independent claims 6, 11, and 12, they recite limitations similar to the limitations argued above with respect to claim 1. Since claims 6, 11, and 12 contain features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially the same reasons, therefore, claims 6, 11, and 12 are patentably distinguishable from (and are patentable over) Zellweger. Moreover, claims 7, 9, and 10 are patentable at least by virtue of their dependency on claim 6, and claims 13-15 are patentable at least by virtue of their dependency on claim 12.

Next, Applicant respectfully addresses the rejection of claims 3 and 8, which depend on claims 1 and 6, respectively. In particular, dependent claims 3 and 8 stand rejected under 35

U.S.C. § 103(a) as being obvious over Zellweger in view of Kanevsky. Applicant has already demonstrated that Zellweger does not meet all the requirements of independent claim 1.

Kanevsky is relied upon only for its teaching of adjusting the size of the display areas. Clearly, Kanevsky does not cure the deficient teachings of Zellweger.

Moreover, one of ordinary skill in the art would not have been motivated to combine the references in a manner suggested by the Examiner. Zellweger is related to displaying supporting annotations along with the main text. The level of the annotation is displayed to the user by indenting or by positioning the annotation text and not by adjusting the size of the text. For example, in Zellweger, the main text is displayed without any indentation, the first level of supporting text (annotation) is displayed with a one indentation, the second level with an additional level of indentation and so on, whereas the size is only adjusted to make room for the additional supporting text that needs to be displayed. Kanevsky, on the other hand, arranges the icons based on relatedness. One of ordinary skill in the art, confronted with a problem of improving the representation of supporting text (annotations) would not have turned to Kanevsky's teachings of arranging icons. Different considerations should be addressed when designing a display for presenting text versus menu icons. In other words, one of ordinary skill in the art would not have been motivated to modify Zellweger's teachings by Kanevsky's teachings of fractal arrangements to show relatedness.

Clearly, Kanevsky does not compensate for the above-identified deficiencies of Zellweger. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1 and 6.

Since claims 3 and 8 are dependent upon claim 1 and 6, respectively, they are patentable at least by virtue of their dependency.

Finally, dependent claim 16 stands rejected as being obvious over Zellweger in view of Hoeber. Claim 16 depends on claim 12. It was already demonstrated that Zellweger fails to teach or suggest all the recitations of the independent claim 12. Hoeber is only cited for its teaching of a push pin and as such clearly fails to cure the deficient teachings of Zellweger. Therefore, claim 16 is patentable at least by virtue of its dependency on claim 12.

Moreover, claim 16 is patentable for at least for the following additional reason.

Dependent claim 16 recites: "piercing a setting pin to a display area corresponding to an element thereby preventing enlargement and reduction of said display area upon further selections." The Examiner acknowledges that Zellweger does not teach or suggest a piercing pin as set forth in claim 16 (see page 8 of the Office Action). The Examiner, however, alleges that Hoeber cures the deficient teachings of Zellweger. This rejection is technically inaccurate for at least the following reasons.

Hoeber teaches that by depressing a push pin, a menu is converted into a window that is retained on the display regardless of other display operations performed. The window may be dismissed, at any time, by placing the cursor over the push pin and momentarily depressing and releasing the first switch on the cursor control device. In addition, in the case of a pop-up window (as opposed to a menu), if the user once again places the cursor over the push pin and momentarily depresses and releases the first switch on the cursor control device, then the

window will be dismissed after the execution of any of the buttons or button stacks disposed within the window (Figs. 3A-3C; col. 2, lines 46 to 50 and col. 7, lines 1 to 34).

This pinned menu window may be manipulated on the display like any other window (col. 7, lines 41 to 48). In Hoeber, windows include resize corners 90 through 93 which are used to shrink or expand borders of a window, thereby changing the area of the window (col. 5, lines 58 to 63). In other words, in Hoeber, the pinning of the window only prevents the window from disappearing from the display. In Hoeber, however, this menu window can still be resized. In other words, Hoeber's push pin is only used to prevent the menu from disappearing from the display and not for preventing the resizing of the menu display area. In short, Hoeber fails to cure the deficient teachings of Zellweger. For at least this additional reason, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 16.

#### **New Claims**

In order to provide more varied protection, claims 17 and 18 are added. Claims 17 and 18 are patentable at least by virtue of their dependency on claims 1 and 6, respectively.

#### **Conclusion and request for telephone interview**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Amendment under 37 C.F.R. § 1.111  
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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